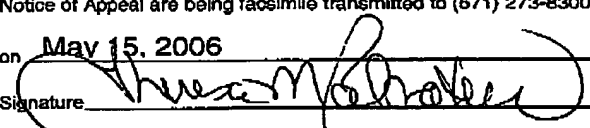



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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 60,469-037; OT-4812	
CERTIFICATE OF FACSIMILE I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300. on <u>May 15, 2006</u> Signature <u></u> Typed or printed name <u>Theresa M. Palmateer</u>		Application Number <u>09/921,803</u> First Named Inventor <u>O'Donnell, Hugh James</u> Art Unit <u>3654</u> Filed <u>08/03/2001</u> Examiner <u>Matecki, Katherine A.</u>	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,139</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u></u> Signature <u>David J. Gaskey</u> Typed or printed name <u>(248) 988-8360</u> Telephone number <u>May 15, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

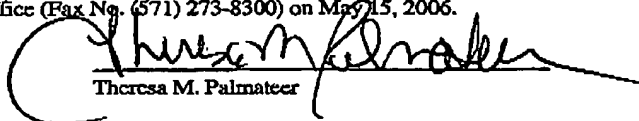
This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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OT-4812

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Theresa M. Palmateer

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60,469-037
OT-4812

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MAY 15 2006

In re application: O'Donnell, et al.
Serial No.: 09/921,803
Filed: 08/03/2001
Group Art Unit: 3654
Examiner: Matecki, Katherine A.
For: ELEVATOR BELT ASSEMBLY WITH WAXLESS COATING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

There is no *prima facie* case of obviousness against any of Applicant's claims for two independently dispositive reasons. The rejection is based upon the proposed combination of DE 3934654 ("the German reference") and US Pat. No. 3,274,322 ("the *Scudder* reference").

One reason why there is no *prima facie* case of obviousness is that the *Scudder* reference does not teach what the Examiner contends; it does not teach a waxless polyurethane. Therefore, the result of the proposed combination is not what the examiner contends and would not be the same as Applicant's invention.

A second and independently dispositive reason why there is no *prima facie* case is that the required motivation for combining references is missing. Where there is no benefit to a proposed combination, there is no motivation for making it and no *prima facie* case of obviousness. There is no benefit to the arrangement of the German reference by incorporating the teachings of the *Scudder* reference. Therefore, the proposed combination cannot be made.

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The German reference discloses a "plastic" belt body with exposed strands at the ends of the belt for establishing electrical connections between the strands. The lifting device of the German reference includes a piston 2, 3 that moves a load 10 vertically by extending or retracting the piston beneath the belt 5. It is important to note that such a lifting arrangement does not rely upon traction between the belt 5 and the pulley 4 to achieve the desired lifting effect.

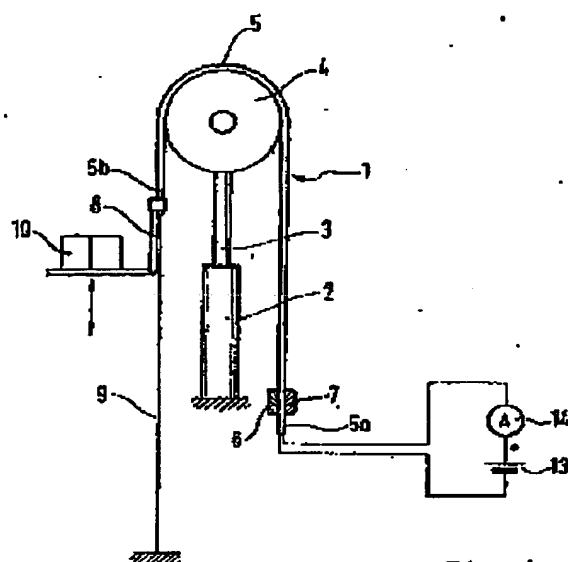


Fig. 1.

The *Scudder* reference teaches a method of forming polyurethane coatings that includes interacting with an uncured polyurethane using a moving surface such as a roller 16. The *Scudder* reference includes applying "liberally, a lubricating barrier in the form of a layer of oily substance, or a thick film, over the layer of polyurethane prior to its being engaged by the second moving surface" such as the roller 16 (Column 1, lines 41-44; Column 2, lines 40-52).

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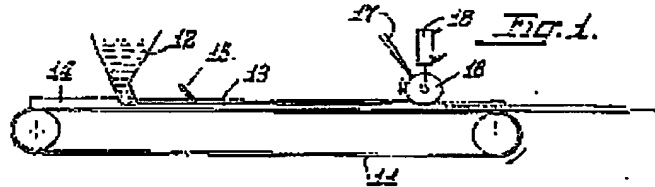
Sept. 20, 1966

J. A. SCUDDER

3,274,322

METHOD OF PLATE FORMING POLYURETHANE AND LIKE MATERIAL

Filed March 2, 1964



Applicant disagrees with the examiner's position that the *Scudder* reference teaches a "waxless" polyurethane. To the extent that the Examiner is relying upon the statements regarding the "sticky" polyurethane in the *Scudder* reference, those are referring to the material before it is fully cured when the material has not yet hardened. That is not a teaching of a polyurethane without wax. Concluding that the *Scudder* reference teaches a waxless polyurethane is not a reasonable interpretation of the reference.

Even if the improper combination were made (e.g., somehow there were some motivation from the references and not from hindsight reasoning based on Applicant's disclosure), the result would not be the same as Applicant's claimed invention. Neither reference teaches a waxless polyurethane. The Examiner's conclusion regarding the *Scudder* reference is incorrect. In column 1, the *Scudder* reference clearly teaches that the semi-plastic state of the polyurethane is what makes it "sticky." That does not in any way suggest that the polyurethane does not contain a wax. Therefore, it cannot "be reasonably interpreted that the polyurethane in *Scudder* does not include wax." The addition of an oily substance in the *Scudder* reference does not suggest that the polyurethane itself does not include wax and stretching the teachings of the reference in that way is not reasonable. There is no *prima facie* case of obviousness.

Assuming for the moment that *Scudder* does disclose a waxless polyurethane (which Applicant denies), there is no motivation for making the proposed combination of the

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German reference and the *Scudder* reference. The polyurethane forming technique of the *Scudder* reference provides no benefit whatsoever in the German reference. That technique will not in any way enhance the ability to make the electrical connections taught in the German reference nor will it in any way make the lifting arrangement of the German reference any different. That lifting arrangement does not present any traction considerations for which a waxless polyurethane might prove useful, for example. No particular traction is required between the "deflection roll 4" and the belt 5 for the arrangement to work as intended.

In other words, adding a waxless polyurethane to the German reference provides no benefit. Where there is no benefit to a proposed combination, there is no motivation for making it and no *prima facie* case of obviousness.

Therefore, even if the *Scudder* reference teaches everything the Examiner contends, there is no benefit for making the combination, the proposed combination cannot be made and there is no *prima facie* case of obviousness.

Respectfully submitted,

CARLSON, GASKEY & OLDS

By: 

David J. Gaskey
Registration No. 37,139
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: May 15, 2006

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Theresa M. Palmateer